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Serial No. 09/845,309
Docket No.: NEC-F100/USA
UDE.003

REQUEST FOR WITHDRAWAL OF FINALITY OF REJECTION

It is requested that the finality of the rejections set forth in the Office Action of November 24, 2004 be withdrawn as premature, since the rejection is a new ground of rejection that was not necessitated by Applicant's amendment, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. §1.197(c).

The Office Action of May 17, 2004 rejected claims 1 and 3-6 under 35 U.S.C. §102(e) as anticipated by Singhal, U.S. Patent No. 6,256,666 and rejected claims 2-3 under 35 U.S.C. §103(a) as unpatentable over Singhal in view of Luzeski et al., U.S. Patent No. 6,301,245. The responding Amendment amended the claims only as to form and argued that they were patentable over Singhal and Luzeski, whether considered separately or in combination. Attached is a copy of claims 1-3 showing the manner in which they were amended. If the Examiner contends that any of the amendments was substantive, he is requested to specifically point out such amendment.

The Office Action of November 24, 2004 rejects claims, including claim 1, under 35 U.S.C. §103(a) as unpatentable over Boyle, et al., United States Patent No. 6,18,158, and rejects claims, including claims 2 and 3, under 35 U.S.C. §103(a) as unpatentable over Boyle et al. in view of Beyda, et al. United States Patent No. 6,275,850. Both Boyle, et al. and Beyda, et al. were listed in the Notice of References Cited (Form PTO-892) which was included with the May 17, 2004 Office Action, but no rejection was based on either of them in that Office Action.

MPEP §707.07(g) states:

"Piecemeal prosecution should be avoided as much as possible. The

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examiner ordinarily should reject each claim on all valid grounds available".
(Emphasis added.)

MPEP §706.07(a) states:

"Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)." (Emphasis added.)

37 C.F.R. §1.97(c) relates to Information Disclosure Statements filed more than three months after the filing date of the application and after a first Office Action. Boyle, et al. was not listed in any Information Disclosure Statement.

The Office Action of November 24, 2004 violates both of these MPEP sections. Clearly, if Boyle, et al., alone or in view of Beyda, et al., provides valid grounds of rejection of the claim 1, or any other claim, as amended in the Amendment of September 10, 2004, then it also provided valid grounds of rejection of the claims prior to that Amendment. In such event, not using Boyle, et al. and Beyda, et al. as grounds of rejection in the May 17, 2004 Office Action, but doing so in the November 24, 2004 Office Action, constitutes piecemeal prosecution.

Clearly, also, using Boyle, et al. and Beyda, et al. as grounds of rejection in the Office Action of November 24, 2004 introduces new grounds of rejection that were neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Accordingly, the November 24, 2004 Office Action should not have been a final

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rejection, and so withdrawal of the finality of the rejection is requested.

Applicant is entitled to the opportunity to amend the claims, if necessary, to any extent appropriate in order to overcome these new grounds of rejection, and so withdrawal of the finality of the rejection is proper.

REMARKS

Even if the finality of the November 24, 2004 Office Action is not withdrawn, entry of this Amendment is proper because it narrows the issues on appeal and does not require further search by the Examiner.

Claims 1-8 and 15-20 are presently pending in the application. Claims 5 and 20 have been amended as to form. Claims 9-14 have been cancelled in the interest of expediting prosecution.

It is noted that the claim amendments are made only to assure grammatical and idiomatic English and improved form under United States practice, and are not made to distinguish the invention over the prior art or narrow the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Objection was made to the title of the application as not descriptive of the claimed invention. The title has been amended to overcome this objection.

Claims 1, 4-6, 9, 12, 15 and 18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boyle, et al., U.S. Patent No. 6,138,158. Claims 2-3, 7-8, 10-11, 13-14, 16-17 and 19-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Boyle, et

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al. and further in view of Beyda, et al., U.S. Patent No. 6,275,850. The cancellation of claims 9-14 makes the rejection of those claims moot. As to claims 1-8 and 15-20, the rejections are respectfully traversed.

THE CLAIMED INVENTION

The claimed invention is directed to a mobile terminal for receiving data through wireless communication channels, and to a method of receiving data through wireless communication channels. The data includes main data and accompanying data. Information about the accompanying data is written in the main data.

Exemplary embodiments of the mobile terminal include a main data acquisition part for acquiring the main data through a predetermined communication channel, an individual accompanying data communication channel determination part for determining a communication channel for receiving the accompanying data according to the information written in the acquired main data, and a communication channel selection part for selecting the communication channel determined by said individual accompanying data communication channel determination part, for receiving the accompanying data.

Some embodiments also send data. Examples of these embodiments include a main data communication channel selection part for selecting a communication channel for sending and receiving the main data, an individual accompanying data communication channel determination part for determining a communication channel for communication of the accompanying data according to the information written in the communicated main data, and an accompanying data communication channel selection part for selecting the communication

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channel determined by said individual accompanying data communication channel
determination part.

Exemplary embodiments of the method include acquiring the main data through a predetermined communication channel; selecting a communication channel to receive the accompanying data based on the information written in the acquired main data; and receiving the accompanying data through the selected communication channel.

Other exemplary embodiments of the method include selecting a main data communication channel for communicating the main data; communicating the main data through the main data communication channel; selecting an accompanying data communication channel to communicate the accompanying data based on the information written in the communicated main data; and communicating the accompanying data through the accompanying data communication channel.

THE PRIOR ART REFERENCES

The Boyle, et al. Reference

Boyle, et al. discloses a wireless communication system in which, when content of a web server is updated, the web server sends users having the content a notification, or electronic message, via a narrowband channel, to make such users aware that there is an update. The notification includes the URL (universal resource locator) of the updated pages, enabling the users to fetch the update via a wideband channel.

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The Beyda, et al. Reference

Beyda, et al. discloses a method and system for management of message attachments. Attachments to e-mail messages are filtered, and if the attachments satisfy certain criteria, then the attachments are downloaded with the respective e-mail messages, but if the attachments do not satisfy the criteria, then the attachments are filtered off, and the e-mail message transmitted without the attachments. The recipient has the option of downloading the attachments separately, if desired.

ARGUMENT

In accordance with the claimed invention, the main data includes information about the accompanying data. In mobile terminals in accordance with the claimed invention, an individual accompanying data communication channel determination part determines a communication channel for receiving the accompanying data according to the information included in the main data. Thus, the individual accompanying data communication channel determination part may determine that the accompanying data is to be received on the same channel as the main data, or it may determine that the accompanying data is to be received on a channel other than the channel on which the main data is received.

In methods in accordance with the claimed invention, a communication channel is selected to receive the accompanying data based on information written in the main data. Again, the accompanying data may be received on the same channel as the main data or on a channel other than the channel on which the main data is received.

In Boyle, et al., the main data, or notification, is sent via a narrowband channel, while

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the accompanying data, or update, is sent via a broadband channel. No determination of the channel to be used is made or required. Use of the broadband channel is dictated by Boyle, et al.'s system.

Beyda, et al. only discloses use of one channel, and thus if the user chooses to download the attachments, they come via the same channel. Again, no determination of the channel to be used is made or required. The same channel is always used.

It is accordingly submitted that the claimed invention distinguishes patentably from Boyle, et al. and Beyda, et al., whether considered separately or in combination, and that the claims are allowable.

CONCLUSION

In view of the foregoing, Applicant submits that claims 1-8 and 15-20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are allowable, and that the application is in condition for allowance. Such action would be appreciated.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below to discuss any other changes deemed necessary for allowance in a telephonic or personal interview.

To the extent necessary, Applicant petitions for an extension of time under 37 CFR §1.136. The Commissioner is authorized to charge any deficiency in fees, including

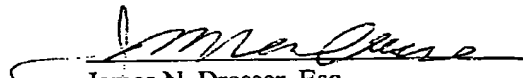
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extension of time fees, or to credit any overpayment in fees to Attorney's Deposit Account

No. 50-0481.

Respectfully Submitted,

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